

REMARKS

Amendments to the Claims

Claims 8, 9 and 16-23 are now pending (support for the limitations of claim 8 can be found for example on pages 6-8 of the specification. It is believed that no new matter has been added.

Foreign Priority Document

Please note that a copy of the foreign priority document was mailed to the office on 20 February 2003 and should be present in the file as of the date of this communication. Please contact the undersigned if the copy has not been received.

35 U.S.C. 112, second paragraph rejection

Claims 9, 13-14 and 18 were rejected under 112, second paragraph for the reasons stated in the final rejection. Paragraph numbers below corresponds to paragraph numbers used in office action.

- (i) With regard to "listing twice" in a Markush group, this alone is not a basis for a holding of indefiniteness - see MPEP 2144.05(h) - page 2100-207 (Rev. 1, Feb. 2003):

"Similarly, the double inclusion of an element by members of a Markush group is not, in itself, sufficient basis for objection to or rejection of claims. Rather, the facts in each case must be evaluated to determine whether or not the multiple inclusion of one or more elements in a claim renders that claim indefinite. ***The mere fact that a compound may be embraced by more than one member of a Markush group recited in the claim does not necessarily render the scope of the claim unclear.*** For example, the Markush group, "selected from the group consisting of amino, halogen, nitro, chloro and alkyl" should be acceptable even though "halogen" is generic to "chloro."

With regard to UVA/UVB filter substances, the examiner appears to answer her own question. The examiner is reminded that MPEP 2173.04 states that "Breadth of a claim is not to be equated with indefiniteness" (see also *in re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971)).

Moreover, maintaining this rejection would appear to cast aspersion on previously issued U.S. patents, e.g. U.S. Patent 6,531,117 (see MPEP 1701 - Office Personnel Not to Express Opinion on Validity or Patentability of Patent).

- (ii) Rejection rendered moot by cancellation.
- (iii) Although the applicants do not agree with the substance of the examiner's rejection, the suggested amendment has been incorporated into claim 18. Such amendment is made with the understanding and interpretation in light of *Festo* that claim 18 as amended does not decrease the scope of claim 18 prior to amendment.

35 U.S.C. 102(b) rejections n/35 U.S.C. 103(a) rejections

Claims 8, 9, 13, 19 and 20 were rejected by the examiner as being anticipated by Caserio et al. (U.S. Patent 4,664,910).

Claims 8, 9, 13, 14, 19 and 20 were rejected by the examiner as being rendered obvious by Caserio et al., *supra* in view of Lyon et al. (U.S. Patent 4,115,313).

Claims 8, 9, 13 and 16-20 were rejected by the examiner as being rendered obvious by Caserio et al., *supra* in view of Tisdale et al. (U.S. Patent 6,103,246).

Claims 8, 9, 13 and 19-23 were rejected by the examiner as being rendered obvious by Caserio et al., *supra* in view of Pittrof et al. (U.S. Patent 5,376,646).

It is believed that the rejections made above have been rendered moot as the claims no longer recite a reference to sodium desoxycholate.

Closing

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that the foregoing Preliminary Amendment (5 pages total) is being deposited with the United States Postal Services as Express Mail Label No. EV 208799406 US in an envelope addressed to: Hon. Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, Mail Stop RCE, on the date indicated below.

Date: **23 May 2003**

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